Yee & Associates, P.C.

4100 Alpha Road
Suite 1100
Dallas, Texas 75244

Main No. (972) 385-8777
Facsimile (972) 385-7766

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Re: Application No.: **09/232,212** Attorney Docket No: AT9-98-567	
Date: Tuesday, August 16, 2005	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Jones et al.**

Serial No.: **09/232,212**

Filed: **January 19, 1999**

For: **System for Controlling Transmission of Information on the Internet**

§ Group Art Unit: **2155**

§ Examiner: **Won, Michael Young**

§ Attorney Docket No.: **AT9-98-567**

§

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By: Amelia C. Turner
Amelia C. Turner

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- Appeal Brief (37 C.F.R. 41.37)

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Respectfully submitted,

Stephen R. Tkacs
Registration No. 46,430
AGENT FOR APPLICANTS

Duke W. Yee
Registration No. 34,285
YEE & ASSOCIATES, P.C.
P.O. Box 802333
Dallas, Texas 75380
(972) 385-8777
ATTORNEY FOR APPLICANTS

Docket No. AT9-98-567 ***PATENT***

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jones et al.	§	
	§	Group Art Unit: 2155
Serial No.: 09/232,212	§	
	§	Examiner: Won, Michael Young
Filed: January 19, 1999	§	
	§	
For: System for Controlling Transmission of Information on the Internet	§	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on June 16, 2005.

The fees required under § 41.20(B)(2), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

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REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 21-41

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: 1-20
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 21-41
4. Claims allowed: NONE
5. Claims rejected: 21-41
6. Claims objected to: NONE

C. CLAIMS ON APPEAL

The claims on appeal are: 21-41

STATUS OF AMENDMENTS

There are no amendments after final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 21:

The presently claimed invention provides a method for communicating over the Internet. The present invention responds to receiving a signal to transmit information created automatically by a process resident on an Internet processor. See specification, page 8, line 27, to page 9, line 3. The present invention identifies at least one information element within the information to be transmitted. See specification, page 9, lines 3-11. The present invention then generates a message that presents the identified information elements to be transmitted and a cancel control so the user can determine whether the information should be sent. See specification, page 9, lines 11-13; page 11; page 12, line 9, to page 14, line 4. Responsive to the user selecting the cancel control, the present invention cancels transmission of the information over the established internet connection. See specification, page 9, lines 13-17; page 13, lines 20-24.

Independent claim 27:

The presently claimed invention provides an apparatus for communicating over the Internet. The present invention responds to receiving a signal to transmit information created automatically by a process resident on an Internet processor. See specification, page 8, line 27, to page 9, line 3. The present invention identifies at least one information element within the information to be transmitted. See specification, page 9, lines 3-11. The present invention then generates a message that presents the identified information elements to be transmitted and a cancel control so the user can determine whether the information should be sent. See specification, page 9, lines 11-13; page 11; page 12, line 9, to page 14, line 4. Responsive to the user selecting the cancel control, the present invention cancels transmission of the information over the established internet connection. See specification, page 9, lines 13-17; page 13, lines 20-24.

The means recited in independent claim 27, as well as dependent claims 28-32, may be data processing hardware within the Internet processor shown in **Figure 1** operating under control of software performing the steps described in the specification at page 8, line 17, to page 9, line 17, or equivalent.

Independent claim 33:

The presently claimed invention provides a computer program product for communicating over the Internet. The present invention responds to receiving a signal to transmit information created automatically by a process resident on an Internet processor. See specification, page 8, line 27, to page 9, line 3. The present invention identifies at least one information element within the information to be transmitted. See specification, page 9, lines 3-11. The present invention then generates a message that presents the identified information elements to be transmitted and a cancel control so the user can determine whether the information should be sent. See specification, page 9, lines 11-13; page 11; page 12, line 9, to page 14, line 4. Responsive to the user selecting the cancel control, the present invention cancels transmission of the information over the established internet connection. See specification, page 9, lines 13-17; page 13, lines 20-24.

A person having ordinary skill in the art would be able to derive computer instructions on a computer readable medium given **Figure 2** and the corresponding description at page 9, lines 13-17; page 13, lines 20-24, without undue experimentation.

Independent claim 39:

In addition to the above, the present invention provides an apparatus for communicating over the Internet. The present invention may also identify at least one information element within the information to be transmitted, the presence of which is unknown to the user. See specification, page 14, lines 1-4. The present invention then generates a message that presents the identified information elements to be transmitted and a cancel control so the user can determine whether the information should be sent. See specification, page 9, lines 11-13; page 11; page 12, line 9, to page 14, line 4. Responsive to the user selecting the cancel control, the present invention

cancels transmission of the information over the established internet connection. See specification, page 9, lines 13-17; page 13, lines 20-24.

Independent claim 40:

In addition to the above, the present invention may also provide an apparatus for communicating over the Internet. The present invention may identify at least one information element within the information to be transmitted, the presence of which is unknown to the user. See specification, page 14, lines 1-4. The present invention then generates a message that presents the identified information elements to be transmitted and a cancel control so the user can determine whether the message should be sent. See specification, page 9, lines 11-13; page 11; page 12, line 9, to page 14, line 4. Responsive to the user selecting the cancel control, the present invention cancels transmission of the information over the established internet connection. See specification, page 9, lines 13-17; page 13, lines 20-24.

The means recited in independent claim 27, as well as dependent claims 28-32, may be data processing hardware within the Internet processor shown in **Figure 1** operating under control of software performing the steps described in the specification at page 8, line 17, to page 9, line 17, or equivalent.

Independent claim 41:

In addition to the above, the present invention provides a computer program product for communicating over the Internet. The present invention may also identify at least one information element within the information to be transmitted, the presence of which is unknown to the user. See specification, page 14, lines 1-4. The present invention then generates a message that presents the identified information elements to be transmitted and a cancel control so the user can determine whether the message should be sent. See specification, page 9, lines 11-13; page 11; page 12, line 9, to page 14, line 4. Responsive to the user selecting the cancel control, the present invention cancels transmission of the information over the established internet connection. See specification, page 9, lines 13-17; page 13, lines 20-24.

A person having ordinary skill in the art would be able to derive computer instructions on a computer readable medium given **Figure 2** and the corresponding description at page 9, lines 13-17; page 13, lines 20-24, without undue experimentation.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection on appeal are as follows:

I. Claims 39 and 40 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention;

II. Claims 21-41 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by *Williams et al.* (U.S. Patent No. 5,815,657).

ARGUMENT

I. 35 U.S.C. § 112, Second Paragraph, Alleged Indefiniteness of Claims 39 and 40

The Final Office Action rejects claims 39 and 40 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. This rejection is respectfully traversed.

With respect to claims 39 and 40, the Final Office Action states:

> The element of claims 39-40, specifically "the at least one information element presence within the information to be transmitted being unknown to a user" raises an issue of ambiguity. The examiner cannot conclude from the specification that such a claimed limitation is an inventive step, but rather the shortfall of prior art that which the applicant(s) are attempting to overcome, as suggested on page 2, lines 15-16 of the specification.

Appellants respectfully disagree. Whether the limitation is part of the shortfall of the prior art or an inventive step is irrelevant when determining whether the claim is definite. The issue is whether the limitation of "identifying at least one information element within the information to be transmitted, the at least one information element presence within the information to be transmitted being unknown to a user" is definite and unambiguous.

In this case, the scope of claim 39, for example, is not unclear or confusing. A person of ordinary skill in the art would recognize that the step of identifying at least one information element actually identifies at least one information element, the presence of which is unknown to the user. In other words, information is to be transmitted and a user does not know of the presence of the identified information element(s) within the information to be transmitted. This is consistent with the present specification, which states:

> In this manner, the user can protect himself against inadvertently disclosing private or secret information by transmitting such information and also prevent his Internet processor from being used to send messages or information to the third parties without his knowledge or consent.

See specification, page 14, lines 1-4. Therefore, the fact that a user does not know of the presence of information element(s) in information to be transmitted is part of the problem of the prior art and identification of the information element(s) is also part of the solution provided by the present invention.

The Final Office Action further states:

> Also, this element of the claimed invention conflicts with the next element "wherein the message presents the at least one information element and includes...so that a user can determine whether the message should be sent".

Appellants respectfully disagree. Each claim element must be considered within its context. In the context of the "identifying" step in claim 39, for example, the presence of the identified information element(s) is unknown to a user; however, in the context of the "generating" step, the previously unknown information element(s) are presented in the generated message "so that a user can determine whether the message should be sent." Furthermore, when read in light of the specification, as shown above, it is clear that the claimed invention identifies information that would otherwise be transmitted by the user unknowingly and presents this information in a generated message.

Claim 40 recites subject matter addressed above with respect to claim 39 and is definite and unambiguous for similar reasons. Therefore, Appellants respectfully request withdrawal of the rejection of claims 39 and 40 under 35 U.S.C. § 112, second paragraph.

II. 35 U.S.C. § 102, Alleged Anticipation of Claims 21-41

The Final Office Action rejects claims 21-41 under 35 U.S.C. § 102(e) as being allegedly unpatentable over *Williams et al.* (U.S. Patent No. 5,815,657). This rejection is respectfully traversed.

IIA. 35 U.S.C. § 102, Alleged Anticipation of Claims 21-38

With respect to claims 21, 27, and 33, the Office Action states:

> As per claims 21, 27, and 33, Williams teaches a method, an apparatus, and a computer program product in a computer-readable medium for communicating over Internet (see col.9, lines 30-32) comprising: responsive to receipt of a signal to transmit information created automatically (see col.19, line 23, "internet browser implemented") by a process resident on the Internet processor over an established Internet connection (see col.15, line 66 to col.16, line 30; Fig.6; and col.19, lines 22-40), identifying at least one information element within the information to be transmitted (see Fig.10; Fig.21; and col.11, lines 5-10, 24-30 & 53-63); generating a message (see col.11, line 6: "browser launches" and col.13, lines 31-36: "GUI components for wallet creation"), wherein the message presents the at least one information element (see col.12, lines 35-40; col.14, line 62 – col.15, line 4; and col.21, lines 25-32) and includes a

> cancel control (see Fig.10, #1010; Fig.11 #1150; Fig.15, #1595; Fig.16, #1695; Fig.17, #1746) for canceling transmission (see col.2, line 66 – col.3, line 7), so that a user can determine whether the message should be sent (see abstract: "user to select"); and responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection (see Fig.13 and col.31, lines 18-20).

Final Office Action, dated February 16, 2005. *Williams* teaches a system, method, and article of manufacture for network electronic authorization utilizing an authorization instrument. An electronic monetary system provides for transactions utilizing an electronic-monetary system that emulates a wallet or purse that is customarily used for keeping money, credit cards, and other forms of payment organized. A user may select an instrument to use for payment and approve the transaction. The instruments in the electronic monetary system are protected by password. Electronic approval results in the generation of an electronic transaction to complete the order. See *Williams*, Abstract. The user may cancel the transaction; however, this cancellation aborts the generation of the information that makes up the transaction. Cancellation of a transaction is not responsive to information being ready for transmission.

In contradistinction, the present invention provides a method, apparatus, and computer program product for allowing a user to determine whether to cancel transmission of itemized information elements in response to the information being automatically created by a process resident on the Internet processor. Claim 21 recites:

> 21. A method, in an Internet processor, for communicating over the Internet, the method comprising:
>
> responsive to receipt of a signal to transmit information created automatically by a process resident on the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted;
>
> generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission, so that a user can determine whether the message should be sent; and
>
> responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection.

Thus, the present invention responds to a signal to transmit information that is created **automatically** by a process resident on the Internet processor and identifies at least one information element in the information to be transmitted. The present invention also generates a message that presents at least one information element and a cancel control and, responsive to

selection of the cancel control, cancels transmission of the information over the established Internet connection.

Williams presents a graphical user interface that allows the user to select any instrument in the monetary system and to approve a transaction. In other words, the graphical user interface of *Williams* allows a user to generate information to be transmitted for a transaction; however, once the information is generated, the information is transmitted and the transaction is completed. Thus, in *Williams*, the cancel controls in Figs. 10 and 11, for example, are used to cancel generation of a transaction. Information is not ready to be transmitted until the transaction is approved and, once the transaction is approved, the transmission cannot be canceled.

Furthermore, *Williams* does not disclose that a signal to transmit information is **automatically** created by a process on the Internet processor. In the present invention, the user is alerted to information of which the user would otherwise have no knowledge. For example, a browser may be about to send sensitive financial information over an Internet connection without the user being privy to the transmission. *Williams* does not recognize this problem. Rather, *Williams* teaches that the user deliberately generates the information through the graphical user interface. Therefore, Appellants submit that *Williams* does not teach or suggest at least identifying at least one information element within information to be transmitted in response to receipt of a signal to transmit information created automatically by a process resident on the Internet processor, generating a message that presents the at least one information element, and canceling transmission of the information responsive to selection of the cancel control, as recited in claim 21. Rather, in *Williams*, the signal to transmit information is created **after** determining that a user selects the information to transmit. Once the **signal to transmit information** is created in *Williams*, there is nothing to prevent the information from being transmitted.

The Final Office Action states:

> In response to the argument regarding claims 1, 27, 33, and 39-41, specifically the element "responsive to a receipt of a signal to transmit information created automatically by a process resident on the Internet processor", the referenced locations clearly teach of a web browser "implemented as a Java applet detects the selection of a payment button" (i.e. automatic). Whether the "automatically creating" was initiated by the user clicking a payment

> button, is irrelevant of the fact that the information to be transmitted *is still created automatically by a process resident on* the Internet processor and sent to the user (see col.16, lines 5-17 & 27-30).

Final Office Action dated February 16, 2005. Appellants respectfully disagree. Clearly, *Williams* does indeed teach that signals are generated automatically. However, claim 21, for example, recites "responsive to a receipt of a signal **to transmit information** created automatically by a process." There is no "signal to transmit information" in *Williams* until the user specifically selects the information elements to be transmitted. As such, there is no **subsequent** step of identifying the information elements within the information to be transmitted, generating a message that presents the information elements, and canceling transmission of the information responsive to the user selecting a cancel control in the message.

The Final Office Action further states:

> Furthermore, the teachings of Williams is consistent with the applicant(s) disclosed invention: "When a user with an Internet processor accesses a web page, an Internet connection is made to the Internet server of the web page and the web page document is transmitted to the Internet processor of the user where the web page document is displayed" (see page 1, lines 13-16). Clearly one of ordinary skill in the art would suggest that the "signal to transmit information created automatically" occurs at both the "Internet processor" and at the "Internet server" by a communication established there between, and clearly is a result of normal browsing action on the Internet (by the clicking of a mouse by the user).

Final Office Action dated February 16, 2005. Appellants respectfully disagree. Certainly, *Williams* teaches the general concept of creating a signal to transmit information. However, it is insufficient for a reference to merely teach the general concept of an invention. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 USPQ2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

In this case, *Williams* does not teach or fairly suggest the claimed steps that occur **responsive** to a signal to transmit information being created automatically by a process on the

client. Rather, as shown above, *Williams* teaches creating a signal to transmit information as a last step before the information is actually transmitted. *Williams* does not teach or suggest, **responsive** to creation of a signal to transmit information, identifying at least one information element within **the information to be transmitted.** It follows that *Williams* also fails to teach or suggest the remaining steps recited in claim 21 that occur subsequent to (as limited by the antecedent basis when the claim is taken as a whole) the signal to transmit information being created.

The applied reference fails to teach or suggest each and every claim limitation; therefore, *Williams* does not anticipate claim 21. Independent claims 27 and 33 recite subject matter addressed above with respect to claim 21 and are allowable for similar reasons. Since claims 22-26, 28-32, and 34-38 depend from claims 21, 27, and 33, the same distinctions between *Williams* and the invention recited in claims 21, 27, and 33 apply for these claims. Additionally, claims 22-26, 28-32, and 34-38 recite other additional combinations of features not suggested by the reference.

Therefore, Appellants respectfully request that the rejection of claims 21-38 under 35 U.S.C. § 102 not be sustained.

IIA1. 35 U.S.C. § 102, Alleged Anticipation of Claims 22, 28, and 34

With respect to claims 22, 28, and 34, the Final Office Action states:

> As per claims 22, 28, and 34, Williams further teaches wherein the message includes a selection control for each information element disclosed in the message (see Fig.10; Fig.11; Fig.14; Fig.21; col.18, line 65 - col.19, line 3; col.22, lines 17-19; and col.31, lines 28-40).

Final Office Action dated February 16, 2005. Appellants respectfully disagree. The cited figures are as follows:

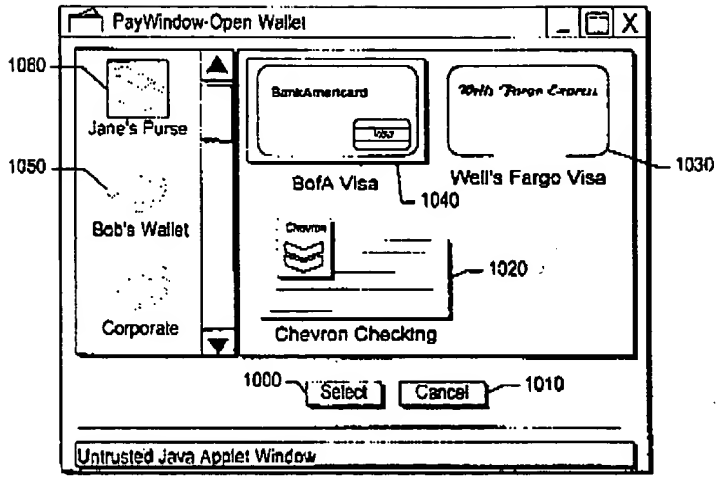


FIG.-10

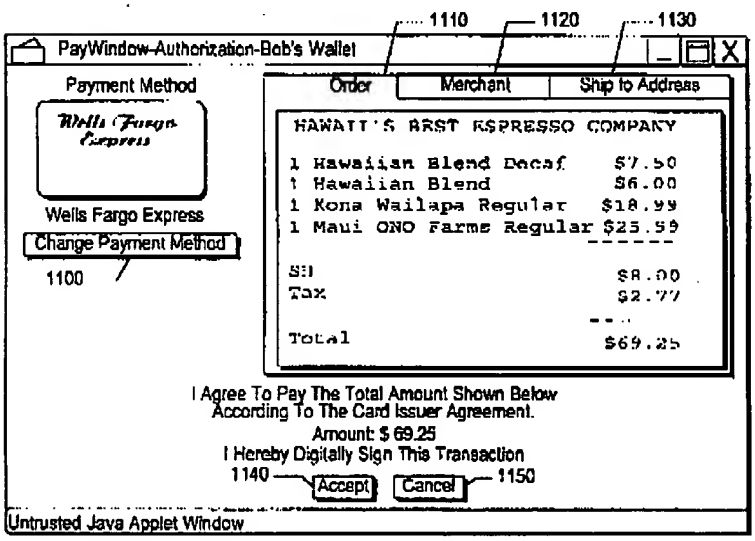


FIG.-11

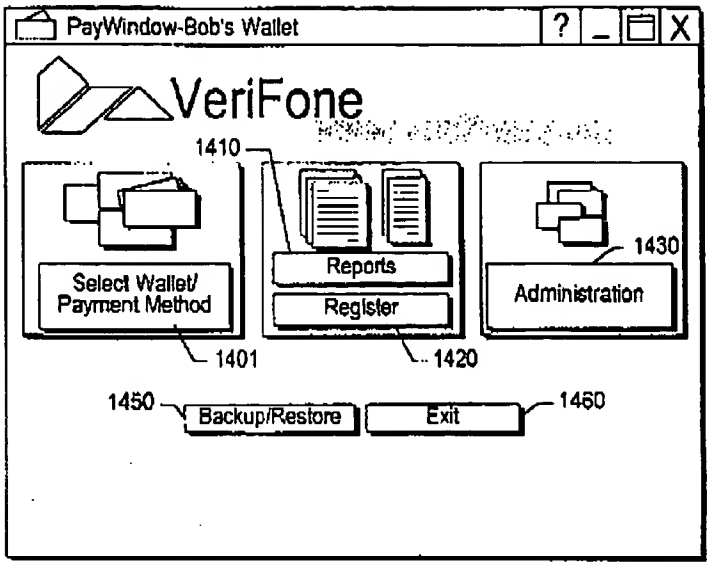


FIG.-14

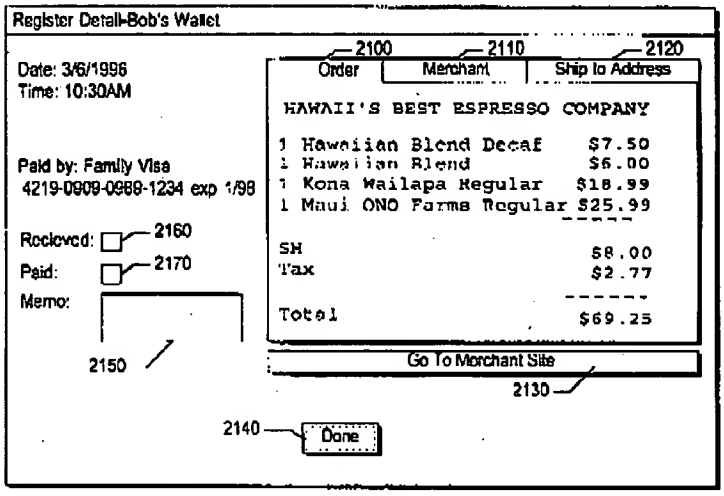


FIG.-21

None of the cited figures, or any other figures, of *Williams* teaches or suggests a message that presents the at least one information element, which are identified from the information to be transmitted, and includes a selection control **for each information element** disclosed in the message. It is unclear how all of these figures are meant to anticipate the single message recited in the claims. Clearly, these figures illustrate multiple screens of display that guide a user

through the selection of a financial instrument well before information is to be transmitted.

Col. 18, line 65, to col. 19, line 3, which is cited in the Final Office Action, states:

> Wallets are user specific and require the particular user to whom the wallet belongs to be effective. A preferred embodiment provides transactions for adding a new payment instrument, deleting a payment instrument, viewing a list of payment instruments and modifying a payment instrument.

This portion makes no mention of a message that presents the at least one information element, which is identified from the information to be transmitted, and includes a selection control for each information element disclosed in the message. Col. 22, lines 17-19, states:

> Clicking on a payment instrument icon puts a border around it, indicating it has been selected.

This portion does use the word "selected"; however, *Williams* does not teach a message that presents the at least one information element, which is identified from the information to be transmitted, and includes a selection control for each information element disclosed in the message. Col. 31, lines 28-40, states:

> The application launches from the desktop. The screen controls include a button for selecting wallet 1401 which displays the paywindow screen and allows a user to open or create a new wallet. Another button, the report button 1410 opens an instance of the report window when it is selected. Selecting the register button 1420 opens the register window which allows a user to select from a variety of register transactions. Selection of the administration button 1430 opens the administration screen which allows a user to perform various administrative tasks. If a user selects the backup/restore button 1450, then the backup/restore dialog is initiated. Finally, selection of the exit button 1460 closes the screen and terminates the application.

Again, this portion does nominally teach selectable controls; however, the controls are not included in a message for each of the at least one information element identified from the information to be transmitted. The applied reference fails to teach or suggest each and every claim limitation; therefore, *Williams* does not anticipate claims 22, 28, and 34.

IIA1(a). <u>35 U.S.C. § 102, Alleged Anticipation of Claims 24, 25, 30, 31, 36, and 37</u>

More particularly, with respect to claims 24, 25, 30, 31, 36, and 37, the Office Action

states:

> As per claims 24, 25, 30, 31, 36, and 37, Williams teach of further comprising: responsive to deselection of a selection control (see col.22, lines 32-36), blocking transmission of the information element corresponding to the selection or deselection control (see col.38, line 6-12: only what has been selected is transmitted). **Note:** what is transmitted and not transmitted resulted by selection or deselection is a matter of programming. This limitation is subjective and does not patentably distinguish the claimed invention. Williams clearly teaches of enabling the user to choose what is transmitted and what is not.

Final Office Action, dated February 16, 2005. Appellants respectfully disagree. Claims 24, 25, 30, 31, 36, and 37 recite blocking transmission of a given information element, within information identified from **a signal to transmit** the information, based on whether a selection control for the given information element is deselected or manipulated. *Williams* merely teaches that a user may not select information that is not to be included when generating information. However, in *Williams* the information is not within information to be transmitted, as identified from a signal to transmit the information, at the time of the selection.

The Final Office Action alleges that Williams teaches Therefore, *Williams* fails to teach or suggest blocking transmission of any given information element that corresponds to a selection control, as recited in claims 24, 25, 30, 31, 36, and 37. The applied reference fails to teach or suggest each and every claim limitation; therefore, *Williams* does not anticipate claims 24, 25, 30, 31, 36, and 37.

IIA1(b). <u>35 U.S.C. § 102, Alleged Anticipation of Claims 26, 32, and 38</u>

With respect to claims 26, 32, and 38, the Office Action states:

> As per claims 26, 32, and 38, Williams further teaches wherein the message presents the address of the Internet server to which the information is to be transmitted (see col. 13, lines 45-47: "merchant URL").

Final Office Action, dated February 16, 2005. Appellants respectfully disagree. The cited portion of *Williams* states:

> The Payment Manager **306** coordinates and completes the payment request that is received from the merchant system. The payment request is received via a MIME message in the native code implementation or via an applet in the Java implementation. The payment request received contains the final GSO, Ship-To name, merchant certificate, merchant URL, coupons and the

> payment amount. The manager **306** then communicates with the payment related GUI component to interact with the consumer to authorize and complete the payment transaction. The manager is also responsible for determining the payment protocol based on the consumer's payment instrument and the merchant's preferred payment protocol.

Williams, col. 13, lines 41-53. While *Williams* does mention the term "merchant URL," the merchant URL is included in a payment request that is received in a MIME message. *Williams* does not teach including an address in a message that presents the at least one information element and includes a cancel control for canceling transmission, as recited in claim 21 on which claim 26 depends. In the claimed invention, it is important to show the destination of the information, because a user may not want certain information to be sent to a particular address. The MIME message of *Williams* is not displayed to the user and, thus, does not fulfill the function recited in the claims.

The Final Office Action states:

> In response to applicant's argument regarding claims 26, 32, and 38, clearly the recited reference teaches of a message that presents the address of the Internet server (see also col.15, lines 62-65 and col.16, lines 14-17).

Final Office Action dated February 16, 2005. Appellants respectfully disagree. The Final Office Action references overlapping portions of the reference, which confuses the actual teachings of the reference. Col. 15, line 60, to col. 16, line3, of *Williams* states:

> Order 530
>
> This message represents the order information which is sent by the browser to the merchant via an HTML form.
>
> Payment Applet with GSO, PPPs, AIs, merchant certificate and URL 540
>
> On receipt of the order, the merchant system calculates the payment amount. This message represents the HTML page which is sent by the merchant system detailing the payment amount along with the Java payment applet which contains the GSO, PPPs, AIs, merchant certificate and URL.

Clearly, this portion references two separate elements, the order message and the payment applet. As evidenced by this cited portion of *Williams*, many messages are created in the course of making a payment. However, *Williams* fails to teach a message that presents the at least one information element identified from a signal to transmit information **and** a cancel control **and**

the address of the Internet server.

Col. 16, lines 13-17, states:

> GSO, PPPs, AIs, merchant certificate and URL 560
> This message represents the GSO, PPPs, AIs, merchant certificate and the merchant URL carried by the Java applet. The Java applet now delivers these to the PayWindow application.

Again, *Williams* teaches several messages that are created in the course of making a payment. Here, the message represents information being transmitted between applications. *Williams* does not teach or suggest a message that presents the at least one information element identified from a signal to transmit information **and** a cancel control **and** the address of the Internet server.

For the above reasons, *Williams* does not anticipate claim 26. Claims 32 and 38 recite subject matter addressed above with respect to claim 26 and are allowable for similar reasons.

IIB. 35 U.S.C. § 102, Alleged Anticipation of Claims 39-41

With respect to claims 39-41, the Office Action states:

> As per claims 39-41, Williams teaches a method, an apparatus, and a computer program product in a computer readable medium in an Internet processor, for communicating over the Internet (see col.9, lines 30-32), the method, apparatus, and computer program product comprising: instructions, responsive to receipt of a signal to transmit information created automatically (see col.19, line 23, "internet browser implemented") by a process resident on the Internet processor over an established Internet connection (see col.15, line 66 to col.16, line 30; Fig.6; and col.19, lines 22-40), for identifying at least one information element to be transmitted (see Fig.10; Fig.21; and col.11, lines 5-10, 24-30 & 53-63), the at least one information element presence within the information to be transmitted being unknown to a user (inherent: uploading of data are unknown to users unless they have been initiated by the user or until the user is notified via a graphical display on the monitor); instructions for generating a message, wherein the message presents the at least one information element and includes a cancel control (see Fig.10, #1010; Fig.11, #1150; Fig.15, #1595; Fig.16, #1695; Fig.17, #1746) for canceling transmission (see col.2, line 66 - col.3, line 7), so that a user can determine whether the message should be sent (see abstract; "user to select"); and instructions responsive to selection of the cancel control, for canceling transmission of the information over the established Internet connection (see Fig.13 and col.31, lines 18-20).

Final Office Action dated February 16, 2005. As stated above with respect to independent claims 21, 27, and 33, *Williams* teaches a system, method, and article of manufacture for network electronic authorization utilizing an authorization instrument. *Williams* presents a

graphical user interface that allows the user to select any instrument in the monetary system and to approve a transaction. In other words, the graphical user interface of *Williams* allows a user to generate information to be transmitted for a transaction; however, once the information is generated, the information is transmitted and the transaction is completed. In other words, the user actually selects the information to be transmitted in *Williams*.

In contradistinction, the present invention provides a method, apparatus, and computer program product for allowing a user to determine whether to cancel transmission of itemized information elements in response to the information being automatically created by a process resident on the Internet processor. Claim 39 recites:

> 39. A method, in an Internet processor, for communicating over the Internet, the method comprising:
>
> responsive to receipt of a signal to transmit information created automatically by a process resident on the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted, the at least one information element presence within the information to be transmitted being unknown to a user;
>
> generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission, so that the user can determine whether the message should be sent; and
>
> responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection.

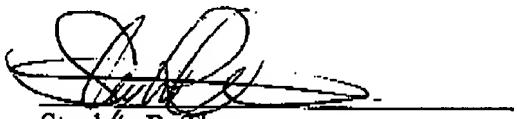
Thus, the present invention responds to a signal to transmit information that is created **automatically** by a process resident on the Internet processor and identifies at least one information element in the information to be transmitted, the presence of which is unknown to a user. The present invention also generates a message that allows a user to determine whether the message should be sent.

Williams does not identify at least one information element the presence of which within the information to be transmitted is unknown to the user. As addressed above, all of the information to be transmitted in *Williams* is specifically selected by the user. At no time is any information to be transmitted unknown to the user. Thus, it follows that *Williams* also fails to teach the step of generating a message that presents the at least one information element and includes a cancel control for canceling transmission, so that the user can determine whether the message should be sent.

The applied reference fails to teach or suggest each and every claim limitation; therefore, *Williams* does not anticipate claim 39. Independent claims 40 and 41 recite subject matter addressed above with respect to claim 39 and are allowable for similar reasons. Therefore, Appellants respectfully request that the rejection of claims 39-41 under 35 U.S.C. § 102 not be sustained.

CONCLUSION

In view of the above, Appellants respectfully submit that claims 21-41 are allowable over the cited prior art and that the application is in condition for allowance. Accordingly, Appellants respectfully request the Board of Patent Appeals and Interferences to not sustain the rejections set forth in the Final Office Action.



Stephen R. Tkacs
Reg. No. 46,430
YEE & ASSOCIATES, P.C.
PO Box 802333
Dallas, TX 75380
(972) 385-8777

CLAIMS APPENDIX

The text of the claims involved in the appeal reads:

21. A method, in an Internet processor, for communicating over the Internet, the method comprising:

responsive to receipt of a signal to transmit information created automatically by a process resident on the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted;

generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission, so that a user can determine whether the message should be sent; and

responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection.

22. The method of claim 21, wherein the message includes a selection control for each information element disclosed in the message.

23. The method of claim 22, wherein each selection control is selected by default.

24. The method of claim 23, further comprising:

responsive to deselection of a selection control, blocking transmission of the information element corresponding to the deselected selection control.

25. The method of claim 22, further comprising:

responsive to manipulation of a selection control, blocking transmission of the information element corresponding to the selection control.

26. The method of claim 21, wherein the message presents the address of the Internet server to which the information is to be transmitted.

27. An apparatus, in an Internet processor, for communicating over the Internet, the apparatus comprising:

means, responsive to receipt of a signal to transmit information created automatically by a process resident on the Internet processor over an established Internet connection, for identifying at least one information element within the information to be transmitted;

means for generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission, so that a user can determine whether the message should be sent; and

means, responsive to selection of the cancel control, for canceling transmission of the information over the established Internet connection.

28. The apparatus of claim 27, wherein the message includes a selection control for each information element disclosed in the message.

29. The apparatus of claim 28, wherein each selection control is selected by default.

30. The apparatus of claim 29, further comprising:

means, responsive to deselection of a selection control, for blocking transmission of the information element corresponding to the deselected selection control.

31. The apparatus of claim 28, further comprising:

means, responsive to manipulation of a selection control, for blocking transmission of the information element corresponding to the selection control.

32. The apparatus of claim 27, wherein the message presents the address of the Internet server to which the information is to be transmitted.

33. A computer program product, in a computer readable medium, for communicating over the Internet, the computer program product comprising:

instructions, responsive to receipt of a signal to transmit information created automatically by a process resident on the Internet processor over an established Internet connection, for identifying at least one information element within the information to be transmitted;

instructions for generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission, so that a user can determine whether the message should be sent; and

instructions, responsive to selection of the cancel control, for canceling transmission of the information over the established Internet connection.

34. The computer program product of claim 33, wherein the message includes a selection control for each information element disclosed in the message.

35. The computer program product of claim 34, wherein each selection control is selected by default.

36. The computer program product of claim 35, further comprising:

instructions, responsive to deselection of a selection control, for blocking transmission of the information element corresponding to the deselected selection control.

37. The computer program product of claim 34, further comprising:

instructions, responsive to manipulation of a selection control, for blocking transmission of the information element corresponding to the selection control.

38. The computer program product of claim 33, wherein the message presents the address of the Internet server to which the information is to be transmitted.

39. A method, in an Internet processor, for communicating over the Internet, the method comprising:

responsive to receipt of a signal to transmit information created automatically by a process resident on the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted, the at least one information element presence within the information to be transmitted being unknown to a user;

generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission, so that the user can determine whether the message should be sent; and

responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection.

40. An apparatus, in an Internet processor, for communicating over the Internet, the apparatus comprising:

means, responsive to receipt of a signal to transmit information created automatically by a process resident on the Internet processor over an established Internet connection, for identifying at least one information element within the information to be transmitted, the at least one information element presence within the information to be transmitted being unknown to a user;

means for generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission, so that the user can determine whether the message should be sent; and

means, responsive to selection of the cancel control, for canceling transmission of the information over the established Internet connection.

41. A computer program product, in a computer readable medium, for communicating over the Internet, the computer program product comprising:

instructions, responsive to receipt of a signal to transmit information created automatically by a process resident on the Internet processor over an established Internet

connection, for identifying at least one information element within the information to be transmitted, the at least one information element presence within the information to be transmitted being unknown to a user;

instructions for generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission, so that a user can determine whether the message should be sent; and

instructions, responsive to selection of the cancel control, for canceling transmission of the information over the established Internet connection.

EVIDENCE APPENDIX

There is no evidence to be presented.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.